

SN 09/597,893
Page 15 of 20

REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed August 11, 2005. In the Office Action, the Examiner notes that claims 1-7, 9-26, 28-45 and 51-58 are pending and rejected. By this response, claims 1, 6, 26, 42, 51, 52, 53, and 54 have been amended.

In view of the foregoing amendments and the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Further, Applicants have addressed the Examiner's Double Patenting Rejections and submit that none of the claims are double patented under the statutory type of double patenting rejection, and that a terminal disclaimer will be filed for those claims being rejected for the judicially created doctrine of double patenting. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

REJECTIONS

Double Patenting

Obviousness Double Patenting

The Examiner has rejected claims 1, 6, 32, 42, 51, and 54 provisionally under the judicially created doctrine of obviousness-type double patenting as being unpatentable over, respectively, claims 1, 7, 34, 43, 51 and 54 of copending Application Serial No. 09/628,805.

In response, Applicants will file a Terminal Disclaimer in the copending Application Serial No. 09/628,805 under 37 C.F.R. 1.130(b) upon indication of allowable subject matter if necessary. As such, the Applicant respectfully request that the obviousness-type double patenting rejection be held in abeyance.

SN 09/597,893
Page 16 of 20

35 U.S.C. §103

Claims 42-45 and 51

The Examiner has rejected claims 42-45 and 51 as being obvious and unpatentable under the provisions of 35 U.S.C. §103(a). In particular, the Examiner has rejected claims 42-45 and 51 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,177,931 to Alexander (hereinafter "Alexander") in view of U.S. Patent 6,493,872 to Rangan (hereinafter "Rangan"). Applicants respectfully traverse the rejection.

Applicants' independent claim 42 (independent claim 51 recites similar relevant limitations) recites:

42. A method for targeting virtual objects to subscribers in a television program delivery system, comprising:
gathering information related to the subscribers;
reporting gathered information related to the subscribers at their terminals to a remote location;
analyzing the gathered information to determine a subscriber profile for one or more of the subscribers;
correlating the subscriber profile with categories of virtual objects, wherein one or more virtual object categories includes at least one virtual object;
selecting a first virtual object and a second virtual object from the correlated virtual object categories, wherein the selecting of the first and second virtual objects comprises:
multiplying, for each at least one virtual objects, a virtual object group ranking percentage by a virtual object location group breakdown percentage to obtain a result for each virtual object; and
ranking the results from best match to worst match; and
designating the first virtual object for display in a video program to a first subscriber and the second virtual object for display in a video program to a second subscriber, wherein the designating of the first and second virtual objects comprising:
assigning a weighting to each of the plurality of virtual objects; and
executing a correlation algorithm. (emphasis added).

The Alexander reference discloses an electronic programming guide which allows for viewer interaction. The Rangan reference discloses marking of data streams relative to another data stream. The Alexander reference fails to disclose selecting of the first and second virtual objects comprises: multiplying, for each at least one virtual

SN 09/597,893
Page 17 of 20

objects, a virtual object group ranking percentage by a virtual object location group breakdown percentage to obtain a result for each virtual object; and ranking the result from best match to worst match; and the designating of the first and second virtual objects comprising: assigning a weighting to each of the plurality of virtual objects; and executing a correlation algorithm. Furthermore, the Rangan reference does not bridge the substantial gap between the Alexander reference and the Applicant's invention. Rangan also does not teach or suggest selecting of the first and second virtual objects comprises: multiplying, for each at least one virtual objects, a virtual object group ranking percentage by a virtual object location group breakdown percentage to obtain a result for each virtual object; and ranking the result from best match to worst match; and the designating of the first and second virtual objects comprising: assigning a weighting to each of the plurality of virtual objects; and executing a correlation algorithm.

There is no motivation to combine because the nature of the problem for Alexander is different than the nature of the problem for Rangan and neither suggests a desire to combine to form the present invention. Even if the two references could somehow be operably combined, the combination would provide selecting of the first and second virtual objects comprises: multiplying, for each at least one virtual objects, a virtual object group ranking percentage by a virtual object location group breakdown percentage to obtain a result for each virtual object; and ranking the result from best match to worst match; and the designating of the first and second virtual objects comprising: assigning a weighting to each of the plurality of virtual objects; and executing a correlation algorithm. Therefore, the combined references fail to teach or suggest the Applicant's Invention as a whole.

As such, Applicants submit that independent claims 42 and 51 and dependent claims 43-45 which depend directly or indirectly from independent claim 42 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

Claims 1-7, 9-26, 28-41, and 52-58

389131-1

SN 09/597,893

Page 18 of 20

The Examiner has rejected claims 1-7, 9-26, 28-41 and 52-58 as being unpatentable over Alexander in view of Rangan and U.S. Patent 5,991,735 to Gerace (hereinafter "Gerace"). Applicants respectfully traverse the rejection.

The Alexander, Rangan and Gerace references alone and in combination fail to teach or suggest Applicants' invention as a whole.

Applicants' independent claims 1, 6, 26 and 52-54 recite different aspects of the present invention. All the above claims include the limitations that in a transmission, determining the one or more virtual objects transmitted comprises: multiplying, for each virtual object, a virtual object group ranking percentage by a virtual object location group breakdown percentage to obtain a result for each virtual object; ranking the result of each virtual object to each virtual object location from best match to worst match; assigning a weighting to each of the plurality of virtual objects; and executing a correlation algorithm.

Neither the Alexander nor the Rangan reference discloses in a transmission, wherein determining the one or more virtual objects transmitted comprises: multiplying, for each virtual object, a virtual object group ranking percentage by a virtual object location group breakdown percentage to obtain a result for each virtual object; ranking the result of each virtual object to each virtual object location from best match to worst match; assigning a weighting to each of the plurality of virtual objects; and executing a correlation algorithm. Therefore, the combined references fail to teach or suggest the Applicant's invention as a whole.

Furthermore, the Examiner's Official Notice is limited to teaching that the use of a PC as a terminal is well-known in the art. Even if the Alexander and Rangan references and the Examiner's Official Notice could somehow be operably combined, the combination would disclose customizing an overlay message to an advertisement in an EPG and sending the customized messages from a head end to the viewer's terminal for use when the advertisement runs. Nowhere in the combined references is there any teaching or suggestion of "in a transmission, wherein determining the one or more virtual objects transmitted comprises: multiplying, for each virtual object, a virtual object group ranking percentage by a virtual object location group breakdown percentage to obtain a result for each virtual object; ranking the results of each virtual object to each

389131-1

SN 09/597,893
Page 19 of 20

virtual object location from best match to worst match; assigning a weighting to each of the plurality of virtual objects; and executing a correlation algorithm.”

The Gerace reference fails to bridge the substantial gap between the Alexander and Rangan references and Applicants’ invention. The Gerace reference discloses a method and apparatus for providing targeting of appropriate audience based on psychographic or behavioral profiles of end users. The Gerace reference fails to teach or suggest Applicants’ in a transmission, wherein determining the one or more virtual objects transmitted comprises: multiplying, for each virtual object, a virtual object group ranking percentage by a virtual object location group breakdown percentage to obtain a result for each virtual object; ranking the results of each virtual object to each virtual object location from best match to worst match; assigning a weighting to each of the plurality of virtual objects; and executing a correlation algorithm. Therefore, the combined references fail to teach or suggest the Applicant’s invention as a whole.

Furthermore, Applicant’s independent claim 32 includes the limitations “determining, for one or more of the video programs and one or more of the targeting categories, targeted virtual objects with overall highest rankings, based on the first and the second percentages” which the examiner asserts is disclosed by Alexander on column 34, line 58-63. Alexander merely discloses that advertisement library, history of use, information boxes are used to analyze what ads to display. It does not disclose teach or suggest “determining, for one or more of the video programs and one or more of the targeting categories, targeted virtual objects with overall highest rankings, based on the first and the second percentages” of the present invention. Both Rangan and Gerace also do not disclose, teach or suggest “determining, for one or more of the video programs and one or more of the targeting categories, targeted virtual objects with overall highest rankings, based on the first and the second percentages.” Thus, even if Alexander, Rangan and Gerace are operably combinable, the combined references still fail to teach or suggest the Applicant’s invention as a whole.

As such, Applicants submit that independent claims 1, 6, 26, 32, 52, 53 and 54 and dependent claims 2-5, 7, 9-25, 28-31, 33-41 and 54-58 which depend directly or indirectly from independent claims 1, 6, 26, 32 and 54 are not obvious and fully satisfy

389131-1

SN 09/597,893
Page 20 of 20

the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

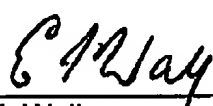
CONCLUSION

Thus, Applicants submit that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. §103. Applicant further submits that Applicant has addressed the Examiner's double patenting rejections and they should be withdrawn. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jasper Kwoh at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 11/9/05



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